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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/977,664  
Filing Date: October 15, 2001  
Appellant(s): HERPST, ROBERT D.

\_\_\_\_\_  
Mr. Rodger Rathbun  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 9/18/08 appealing from the Office action  
mailed 11/23/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,764,355	GAGNON ET AL.	9-1998
4,843,030	EDEN ET AL.	6-1989
4,932,780	IZUMI	6-1990
4,855,110	MARKER ET AL.	8-1989

Applicants' admitted prior art on page 5 lines 6-19 of the original specification.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1-20, 28,30-33,35-37,30-44 and 46-53 are rejected under 35 U.S.C. 103(a) as being unpatentable Gagnon et al. (USP 5,764,355) in view of Eden et al. (USP 4,843,030), further in view of Applicants' admitted prior art (pages 5 lines 6-19 of the original specification) or Izumi (USP 4,932,780).

Gagnon et al. teach an IR sample holder made of a first material that does not transmit IR radiation having an aperture containing a second material where the sample is applied that transmits IR radiation. Column 5 lines 33+ teach the second IR transmitting material may be glass, quartz or polymeric materials.

Gagnon et al. are silent to the claimed steps of forming the composition.

Eden et al. teach in column 10 lines 26+ that it is known to cleave NaCl crystal to achieve the desired size of crystal. Cleavage has the advantage of insuring separation along precise well determined orientation of the crystal.

It would have been within the skill of the art to modify Gagnon et al. and use a cleaving method to cut the crystal to gain the above advantages.

The modified sample holder of Gagnon et al. is silent to the specifically claimed glass compositions of the glass, specifically the alkali halide such as potassium bromide/chloride and sodium chloride and if the glass is unpolished.

The court decided In re Leshin (125 USPQ 416) that selection of a material based upon its suitability of intended use would have been within the skill of the art in view of 35 USC 103.

Alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride are well known in the art and advantageous because of their low cost, excellent optical properties and hardness.

It would have been within the skill of the art to modify Eden et al. and use an alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride to gain the above advantages and in view of Leshin because selection a material based upon its suitability of intended use.

Applicants' state on pages 3-5 it is known in the art to place sample for IR analysis in highly polished crystal cuvettes. Page 5 in the second paragraph states that it is known in the art to use both polished and unpolished crystal blanks for IR analysis. The unpolished blanks are taught as costing less to manufacture than the polished.

Izumi teach in column 2 lines 24+ polishing KBr crystal is expensive and that a high polishing is needed for wavelengths other than the IR range.

It would have been within the skill of the art to further modify the modified device of Gagnon et al. in view of Applicants' admitted prior art or Izumi and not polish the crystal to minimize the cost of production.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gagnon et al. (USP 5,764,355) in view of Eden et al., further in view of Applicants' admitted prior art (pages 5 lines 6-19 of the original specification) or Izumi (USP 4,932,780) together further in view of Marker et al. (4,855,110).

See Gagnon et al. (USP 5,764,355) in view of Eden et al., further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780).

The art is silent to the use of a carousel for containing the slide to interface with an analyzer.

Marker et al. teach the use of a carousel in an automated analyzer. The carousel has the advantages of providing immediate access to all of the samples, which enables "stat" analysis of an important sample. Automated analyzers have the additional advantages of reducing human error, lower labor costs and permit 24/7 operations.

It would have been within the skill of the art to modify Gagnon et al. (USP 5,764,355) in view of Eden et al., further in view of Applicants' admitted prior art (pages 3-8 of the original specification) or Izumi (USP 4,932,780) together further in view of Marker et al. and use a carousel engaged with an automated analyzer to gain the above advantages.

#### **(10) Response to Argument**

In the last paragraph on page 11, Appellant states the corresponding UK application was "immediately allowed" which evidences the novelty and unobviousness

of the present claims over the art of record. The Office cannot comment on the findings of the UK Patent Office and maintains the rejections of record are proper.

On pages 13-19, Appellant states Gagnon relates to the sample receiving means being a screen or microporous sheet where the screen is glass, quartz, metals and alloys. Appellant states the taught materials of the screen cannot be read on the instant claims because they are not "infrared red transmitting." The Office acknowledges Gagnon alone does not clearly anticipate the instant claims. Rather, Gagnon has been applied under 35 USC 103 with proper motivation to include the claimed alkali halide crystal. The Office maintains the rejections of record properly meet all of the claimed limitations. It appears Appellant is arguing the references individually; however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On page 20, Appellant states the secondary reference Eden fails to teach cleavage of alkali halide crystals to achieve transmission of IR radiation or as a substrate for spectroscopy. These remarks are not commensurate in scope with the rejections of record that do not rely upon Eden to teach the claimed method of use. Rather, the rejections of record use Eden to teach it is known to cleave alkali halide crystal materials.

In the last paragraph of page 20 through page 24, Appellant traverses the application of Izumi. Appellant states Izumi teaches polishing the blanks is expensive

and time consuming, but fails to teach it is known to use unpolished blanks for spectrometry. Further, Appellant states on page 21 lines 6-8 of the 9/18/08 Brief, unpolished blanks were commonly sold but considered unsuitable for spectroscopic analysis. There is evidence of record that teaches refuting this statement of unsuitability for spectroscopic analysis. Specifically, Applicants' admitted prior art on page 5 lines 6-19 of the original specification that states "Spectroscopists have, for many years, used polished crystals and unpolished crystal blanks to perform qualitative and quantitative analysis ... with IR and FTIR spectroscopic instruments." It is not clear how Appellant can state it was not known to use unpolished crystals for spectroscopic analysis in light of their own disclosure. The Office maintains there is sufficient motivation of record to use have employed unpolished crystals.

On pages 24 through 37 Appellant states the 5 different 37 CFR 1.132 Declarations of record are convincing to demonstrate various aspects of the invention such as commercial success and the unobviousness of the invention. The first issues raised by Appellant traverses the position taken by the Office that the respective Declarations represent the opinions of the Declarant and do not have sufficient weight to overcome the rejections of record. The Office has previously referenced MPEP 716.01(c) III to support their positions that the appropriate weight has been given to the opinions set forth in respective Declarations. Further support can be found in MPEP 2164.05 which reiterates the proper weight to be given to an expert's opinion and is consistent with the rejections of record.



Appellant state the Declarations showing commercial success were not given the appropriate weight. The Office maintains the Affidavits were not sufficient to show commercial success as required by MPEP section 716.01.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Lyle A Alexander/

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